

REMARKS

By this Amendment, claim 3 is amended. Support for the changes to claim 3 can be found, *inter alia*, at page 10, lines 10-19, and in Figures 15 and 16.

Claims 1, 2 and 9-12 were canceled previously. Claims 5-8 stand withdrawn from consideration. Claims 3 and 4 are presented for further examination.

The rejection of claims 3 and 4 under 35 U.S.C. § 112, first paragraph, for allegedly containing new matter is respectfully traversed.

Applicants respectfully submit that the changes to claim 3 do not introduce new matter, but merely recite subject matter implicitly and/or inherently disclosed in the application as filed. The introduction of such implicit or inherent subject matter is clearly not new matter. See MPEP § 2163.

In response to the Examiner's assertion that the method steps of amended claim 3 are not disclosed in any single embodiment, there is no requirement that the subject matter of a later claim be described literally or "in haec verba" in order to satisfy the description requirement. Rather, it is sufficient that the specification "convey clearly to those skilled in the art, to whom it is addressed, in any way, the information that the applicant has invented the specific subject matter later claimed." *In re Wertheim*, 541 F.2d 257, 262 191 USPQ 90, 97 (CCPA), appeal after remand, 646 F.2d 527, 209 USPQ 554 (CCPA 1981).

Thus, in the present case, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of

the filing date sought, applicant was in possession of the invention as presently claimed. MPEP § 2173.02.

According to a first embodiment of the invention, a dielectric film 3 is deposited and etched to form a groove, and a dielectric material 4 is embedded into the etched groove to form a transmission line (see page 7, line 8-page 8, line 36 and Figures 1-6). According to a second embodiment of the invention, a dielectric film 4 is formed and then removed everywhere except the portion thereof necessary to form a transmission line. In the second embodiment, after the dielectric film 4 is etched, a dielectric 3 is embedded in the areas from which the dielectric film 4 has been removed (see page 9, line 5-page 9, line 21 and Figures 7-9).

As explicitly disclosed in the specification, the second embodiment (Figures 7-9) is a modified example of the dielectric film formation process of the first embodiment (Figures 2-4), which results in the same structure as the first embodiment (see page 9 of the specification).

The third embodiment relates to an inventive fabrication method for constructing a non-radiative dielectric waveguide. While the third embodiment uses the dielectric film formation process of the first embodiment, because the first and second embodiments are taught to be modified examples of each other that produce the same structure, one of ordinary skill would conclude that the

dielectric film formation process of either the first or second embodiment could be used in constructing the claimed non-radiative dielectric waveguide.

It would not be rationale to require an Applicants' specification to explicitly recite every possible combination of the features disclosed therein. In the present case, Applicants have clearly disclosed that the process of the second embodiment is a modified example of the process of the first embodiment, which can be used to form an identical dielectric film structure. In view of such a disclosure, one of skill in the art would readily conclude that the scope of the amended claims is commensurate with the scope of the originally-filed specification, and that Applicants had demonstrated possession of the invention recited in claims 3 and 4 at the time the application was filed. In view of the foregoing, reconsideration and withdrawal of the rejection under § 112, first paragraph are respectfully requested.

The rejection of claim 3 under 35 U.S.C. § 102(b) over Ishikawa, US 5,652,557 is respectfully traversed with respect to the amended claim.

As amended, claim 3 requires that the second conductive film be embedded in an area where the second sacrificial layer has been etched away, and that both the first and second sacrificial layers be removed after the step of embedding the second conductive film. This required sequence of steps is neither disclosed nor suggested by Ishikawa.

As noted in the Office Action, Ishikawa discloses the formation of a conductor line 3 (second conductive film) after etching dielectric 5' and protective layer 20. However, Ishikawa does not disclose a step of removing the dielectric 5' and protective layer 20 after embedding the conductor line 3. Rather, Ishikawa explicitly teaches that the conductor line 3 and grounded conductor 2 formation is the final step in the disclosed method of fabrication (see, e.g., column 14, lines 40-59).

Because Ishikawa fails to disclose or suggest all of the steps of the claimed invention, reconsideration and withdrawal of the rejection are respectfully requested.

The rejection of claim 4 under 35 U.S.C. § 103(a) as obvious over Ishikawa in view of Smith, US 6,611,237, is respectfully traversed.

Smith, which was cited for disclosing a MEMS formed in a substrate, fails to remedy the deficiencies of Ishikawa with respect to claim 3. Claim 4 is deemed allowable at least for the reasons that independent claim 3 is allowable. Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #101249.55938US).

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